

# The United States of America



## The Commissioner of Patents and Trademarks

*Has received an application for a patent for a new and useful invention. The title and description of the invention are enclosed. The requirements of law have been complied with, and it has been determined that a patent on the invention shall be granted under the law.*

*Therefore, this*

### United States Patent

*Grants to the person(s) having title to this patent the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States of America or importing the invention into the United States of America for the term set forth below, subject to the payment of maintenance fees as provided by law.*

*If this application was filed prior to June 8, 1995, the term of this patent is the longer of seventeen years from the date of grant of this patent or twenty years from the earliest effective U.S. filing date of the application, subject to any statutory extension.*

*If this application was filed on or after June 8, 1995, the term of this patent is twenty years from the U.S. filing date, subject to any statutory extension. If the application contains a specific reference to an earlier filed application or applications under 35 U.S.C. 120, 121 or 365(c), the term of the patent is twenty years from the date on which the earliest application was filed, subject to any statutory extension.*

*Bence Lehman*

Commissioner of Patents and Trademarks

*Armitra Manley*

Attest

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Applicant:** Harold Kohn

**Examiner:** S. Kumar

**Serial No.:** 08/818,688

**Art Unit:** 1209

**Filed:** March 17, 1997

**Docket:** REI-10030

**Reissue of Patent No.:** 5,773,475

**Issued:** June 30, 1998

**For:** ANTICONVULSANT ENANTIOMERIC  
AMINO ACID DERIVATIVES

**Dated:** January 28, 2002

Assistant Commissioner for Patents  
Washington, DC 20231

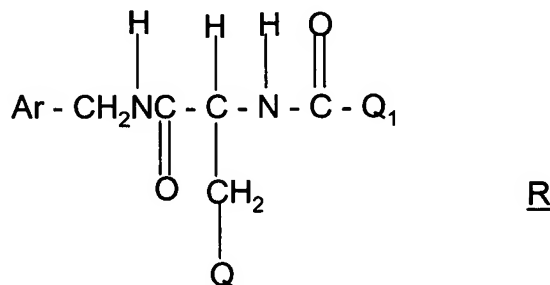
LETTER

Sir:

This re-issue application is being filed to perfect the claim of priority for a provisional application in which the claim of priority was made during the pendency of the underlying application for the '475 patent.

The facts are outlined in the Declaration by the inventor, Dr. Harold Kohn, (hereinafter referred to as the "Kohn Declaration"), filed concurrently herewith, and are summarized hereinbelow.

A provisional application was filed on March 15, 1996 and was assigned Serial Number U.S.S.N. 60/013,522 (hereinafter "provisional application"). The application was directed, inter alia, to a compound in the R configuration having the formula:



wherein

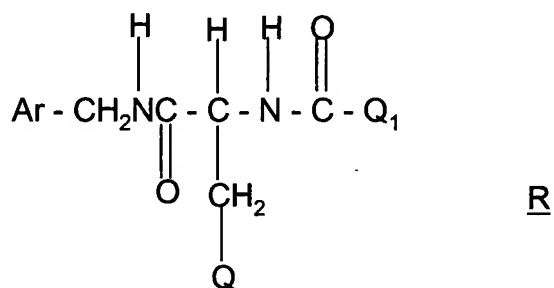
Ar is phenyl which is unsubstituted or substituted with at least one halo group;

Q is lower alkoxy; and

Q<sub>1</sub> is methyl.

It was also directed, inter alia, to a method of treating central nervous system disorders in an animal comprising administering to said animal in need thereof an anti-convulsant effective amount of said compound. See Kohn Declaration, Paragraph 11.

The U.S. patent application based thereon, which was assigned Serial Number 08/818,688 (hereinafter "'688 application"), was also directed to a compound in the R configuration having the formula:



wherein

Ar is phenyl which is unsubstituted or substituted with at least one halo group;

Q is lower alkoxy; and

Q<sub>1</sub> is methyl.

The utility application was also directed, inter alia, to a method of treating central nervous system disorders in an animal comprising administering to said animal in need thereof an anti-convulsant effective amount of said compound. See Kohn Declaration, Paragraph 6.

The subject matter in the '688 application is directed to the same compounds and to the same uses as described in the underlying provisional application. Thus, the subject matter

of the '688 application was described in the underlying provisional application in compliance with the requirements of 35 U.S.C. §112, first paragraph.

The first sentence of the '688 application as filed, claimed priority from the provisional application. It stated:

This application claims priority from U.S. Provisional Application No. 60/013,522 filed March 15, 1996.

See Exhibit B attached to the Kohn Declaration. The '688 application was filed on March 17, 1997, which was the first business day after the one-year anniversary date of the filing of the provisional application of March 15, 1997, which fell on a Saturday.

In accordance with 35 U.S.C. §119(e), the '688 application was timely filed, and thus is entitled to the priority of the provisional application.

35 U.S.C. §119(e) reads, in part, as follows:

(e)(1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director...

(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional

application shall be extended to the next succeeding secular or business day...

As originally filed, the '688 application had reference to the earlier filed provisional application. Inasmuch as the 12 month date of the filing of the provisional application i.e., March 15, 1997, fell on a Saturday in 1997, according to 35 U.S.C. §119(e)(3) the period of pendency of the provisional application was extended to the next succeeding secular or business day, i.e., March 17, 1997, and thus under the statute, when the application was filed on March 17, 1997, it was copending at the time of the filing thereof with the provisional application. Thus, the '688 application should be accorded the priority of the provisional application.

Although the amendment to 35 U.S.C. §119(e), which added, inter alia, 35 U.S.C. §119(e)(3), took effect on November 29, 1999, which was subsequent to the issuance of the '475 patent, attention is directed to the American Inventors Protection Act of 1999, Pub. L. 106-113, Div. B, §1000(a)(9) [Title IV of the "Intellectual Property and Communications Omnibus Reform Act of 1999", §4801(d)], 113 Stat. 1536, 1501A-589, (1999). This is reprinted, in part, with the appropriate annotations, in the Historical and Statutory Notes of 35 U.S.C.A. §119 (West Supp. 2001), which reads as follows:

"The amendments made by this section [amending this section and section 111 of this title] shall take effect on the date of the enactment of this Act [Nov. 29, 1999, which is the date of enactment of Pub. L. 106-113, 113 Stat. 1501, which in Div. B. §1000(a)(9), enacted into law this act as an Appendix] and shall apply to any provisional application filed on or after June 8, 1995, except that the amendments made by subsection (b) and (c) [amending subsec. (e) of this section] shall have no effect with respect to any patent which is the subject of litigation in an action commenced before such date of enactment."

Accordingly, the amendment to 35 U.S.C. §119(e) applies to any provisional application filed on or after June 8, 1995, with the exception noted above. Inasmuch as the language of §4801(d) of Title IV refers to a patent and indicates that the only exception is a patent which is the "subject of litigation in an action commenced before such date of enactment", it is apparent that 35 U.S.C. §119(e) is applicable to an issued patent, with the exception noted hereinabove based on a provisional application filed on or after June 8, 1995. Moreover, the '688 application was filed on March 17, 1997, which is subsequent to the June 8, 1995 date. Inasmuch as the '475 patent was not involved in any litigation in an action commenced before the "date of enactment" or otherwise, the amendment to 35 U.S.C. §119(e) applies to the present patent. Accordingly, in accordance with 35 U.S.C. §119(e), the '688 application is entitled to the priority date of the provisional application. Thus, it is respectfully requested that the '475 patent be accorded the priority of U.S.S.N. 60/013,522.

In the event that additional fees are associated with this filing, the Commissioner is authorized to charge Deposit Account No. 19-3886/RCT. A duplicate copy of this sheet is enclosed.

Respectfully submitted,



Mark J. Cohen  
Registration No. 32,211

SCULLY, SCOTT, MURPHY & PRESSER  
400 Garden City Plaza  
Garden City, NY 11530  
(516) 742-4343

MJC:lf